

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RYUICHI OKASHITA and NAOYASU SUGIMOTO

Appeal No. 1999-0279
Application No. 08/926,986¹

ON BRIEF

Before MEISTER, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3 through 5, which are all of the claims pending in this application.

¹ Application for patent filed September 10, 1997. According to the appellants, the application is a continuation of Application No. 08/669,825, filed June 26, 1996, now abandoned, which was a continuation of Application No. 08/360,060, filed December 20, 1994, now abandoned.

Appeal No. 1999-0279
Application No. 08/926,986

We REVERSE.

BACKGROUND

The appellants' invention relates to a steering apparatus for an automotive vehicle. An understanding of the invention can be derived from a reading of exemplary claim 5, which appears in the appendix to the appellants' brief.

The claims on appeal stand rejected on the following grounds:

- (1) Claims 3 through 5 under 35 U.S.C. § 112, first paragraph, as the specification fails to adequately teach how to make and/or use the invention, and
- (2) Claims 3 through 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (mailed July 16, 1998) for the examiner's complete reasoning in

support of the rejections, and to the appellants' brief (filed April 28, 1998) for the appellants' arguments thereagainst.

OPINION

Initially we note that issues 3 and 4 set forth on pages 2 and 7-8 of the brief (i.e., the examiner's objection to the drawings and the examiner's objection to the specification) relate to petitionable matters and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review issues 3 and 4 raised by the appellants.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We will not sustain the rejection of claims 3 through 5 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty,

a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. The examiner determined (answer, pp. 4-5) that two phases recited in claim 5 were indefinite, namely

- (1) taking into account a lateral inclination of the road surface, and
- (2) a ply-steer residual cornering force of tires on the road surface.

We agree with the appellants' argument (brief, pp. 6-7) that the claims under appeal are definite (i.e., the claims do fully apprise those of ordinary skill in the art of the scope of the invention claimed), and thus satisfy the requirement of 35 U.S.C. § 112, second paragraph, to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. In this regard, we note that breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689,, 169 USPQ 597 (CCPA 1971). Thus, while the two phrases in question may have a broad scope, the phrases themselves do not introduce any indefiniteness into the claimed subject matter.

For the reasons stated above, the decision of the examiner to reject claims 3 through 5 under 35 U.S.C. § 112, second paragraph, is reversed.

The enablement issue

We will not sustain the rejection of claims 3 through 5 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art **without undue experimentation.** See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and

using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of

35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellants to present persuasive

arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973).

Thus, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention **without undue experimentation**. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. Clearly, the examiner has not met this burden. In that regard, the examiner has not provided any reasoning² as to why one skilled

² Factors to be considered by an examiner in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability
(continued...)

in the art would not have been able to make the claimed "first and second dust boots" as recited in claim 5 **without undue experimentation.**

In addition, while the examiner is correct that the appellants' disclosure does not show or describe any means that would allow adjustable attachment of the boots, we note that such adjustable attachment is not claimed.

For the reasons stated above, the decision of the examiner to reject claims 3 through 5 under 35 U.S.C. § 112, first paragraph, is reversed.

²(...continued)
of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

CONCLUSION

To summarize, the decision of the examiner to reject claims 3 through 5 under 35 U.S.C. § 112, first and second paragraphs, is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1999-0279
Application No. 08/926,986

Page 13

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APPEAL NO. 1999-0279 - JUDGE NASE
APPLICATION NO. 08/926,986

APJ NASE

APJ McQUADE

APJ MEISTER

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 08 Jun 99

FINAL TYPED: